

U.S. Serial No.: 09/367,712
Fil d: August 18, 1999

[fluocinolone acetonide].

REMARKS

The present invention provides a method for treating proliferative skin diseases comprising the administration of an effective amount of tazarotene and an effective amount of a mid-or high-potency corticosteroid. (See claim 1) Preferably tazarotene and said mid- or high-potency corticosteroid are applied topically to the psoriatic skin of a human subject. (See claim 6). More preferably the corticosteroid is a high potency corticosteroid (See claims 12 and 13)

The Examiner has objected to claim 5 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 5 (See claim 5, twice amended) is amended to place the claim in proper dependent form.

The Examiner has rejected claims 1-3, 5-8, 10-13 under 35 USC § 103(a) as being unpatentable over Yamamoto ('906) and Nagpal et al. ('279) in combination.

The Examiner argues that "(I)t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the use of tazarotene (Nagpal '279) and an adrenocortical hormone (Yamamoto '906) in the treatment of psoriasis."

The Applicant has demonstrated that mid- or high-potency corticosteroids in combination with tazarotene exhibit a synergistic effect that provide a more effective treatment of psoriasis than tazarotene, alone, or with a low-potency corticosteroid. (See lines 20-23 of page 9 of the present specification.)

The unpredictable results for the combination of the mid- or high-potency

corticosteroids with tazarotene are given in Example 1. (See page 10, line 28 through page 11, line 5 of the present specification and Figure 1.)

Based on effectiveness of each individual component and the synergistic effect of the combination of the two components in an unpredictable technology (Testing of the combinations was required to demonstrate effectiveness or lack thereof.), there is no *prima facie* obviousness of predictable results. One must consider the predictability of the technology, MPEP 2144.08(e). It is well known that the field of pharmaceuticals is unpredictable. Even if two separate pharmaceuticals are indicated for the same treatment, success is not known until both pharmaceuticals are tried. In an unpredictable technology, it is less likely that structurally similar species will render a claimed species obvious, because it may not be reasonable to infer that the species would share similar properties. This is the epitome of the incorrect obviousness standard of obvious to try. See e.g., *In re O'Farrell* 7 USPQ2d 1680 (Fed. Cir. 1988), *In re Merck & Co., Inc.* 231 USPQ 381 (Fed. Cir. 1986), *In re May* 197 USPQ 601, 611 (CCPA 1978).

The Examiner has rejected Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Smith ('074) or Sequeira et al. ('529) in combination with Nagpal et al. ('279). The Examiner admits that Smith and Sequeira et al. teach only the use of corticosteroids, such as alclometasone dipropionate and betamethasone dipropionate in the the treatment of psoriasis and Nagpal et al. teach only the use of tazarotene in the treatment of psoriasis. The Examiner argues that "the ordinary artisan would be motivated to use combination treatment". When applying 35 U.S.C. 103, one must adhere to the following tenet: "(C) The references must be viewed without the benefit of impermissible hindsight vision afforded

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by the claimed invention", MPEP 2141. As testing of the combinations was required to demonstrate effectiveness or lack thereof, there is no *prima facie* obviousness of predictable results. One must consider the predictability of the technology, MPEP 2144.08(e). It is well known that even if two separate pharmaceuticals are indicated for the same treatment, success can not be predicted until both pharmaceuticals are tried.

For the foregoing reasons Applicant respectfully requests that the Examiner withdraw this rejection. Accordingly, the claims are now in condition for allowance and a notice to that effect is respectfully requested.

While no fee is thought to be due in connection with this communication, if Applicant is in error in this regard please use Deposit Account No. 01-0885 for the payment thereof.

Respectfully submitted,

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